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JBP-462  
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Docket No. JBP-462

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Charles E. Clum  
Jonas C.T. Wang

Serial No. : 09/360,805

Art Unit: 1614

Filed : July 23, 1999

Examiner: Hollinden, G.

For : Retinoid Compositions Containing a Water Soluble  
Antioxidant and a Chelator

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first class mail in an envelope addressed  
to: Assistant Commissioner for Patents, Washington, D.C. 20231 on

May 19, 2000

(Date)

William E. McGowan

Name of applicant, assignee, or Registered Representative

(Signature)

May 19, 2000

(Date of Signature)

Assistant Commissioner for Patents  
Washington, D.C. 20231

MAY 25 2000

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REQUEST FOR RECONSIDERATION

Dear Sir:

This communication is submitted in response to the Official  
Action of February 22, 2000 ("Office Action"). Reconsideration

and allowance is respectfully requested. Claims 1-63 are pending.

Applicants further submit herewith a Supplemental Declaration for both Charles E. Clum and Jonas C.T. Wang. The new Declarations correct three typographical errors on page 2, paragraph 3 of the declarations, where an incorrect patent number was entered, the word "retinoid" was misspelled, and a method feature (m16) was incorrectly numbered.

Objection to Declaration of Drs. Wang and Clum

The Examiner on page 2 of the Office Action objected to the above-referenced patent application because the error that is relied on to support the reissue application was "not an error upon which a reissue can be based." Applicants respectfully disagree.

According to the Examiner, the failure to "timely file a divisional application is not considered to be an error causing a patent granted to be partially inoperative by reason of claiming less than they had right to claim." See Page 2 of the Office Action. Applicants do not fully understand the Examiner's assertion, since a restriction requirement was never issued during the prosecution of U.S. Patent No. 5,652,263. The

statements referred to by the Examiner in MPEP § 1450 refer only to a case where a restriction requirement was made. See In re Watkinson, 900 F.2d 230 (Fed. Cir. 1990) (acquiescence in *restriction requirement* was not correctable by reissue), cited in MPEP § 1450.

While U.S. Patent No. 5,652,263 is a divisional of U.S. Patent No. 5,559,149, the divisional patent application was filed voluntarily and not filed pursuant to a restriction requirement. Furthermore, no restriction requirements were issued by the PTO during the prosecution of any of the prior patent applications from which the above-referenced application claims priority (i.e., U.S.S.N.s 153,543, filed on November 16, 1993, 719,264, filed on June 27, 1991, and 471,760, filed on January 29, 1990). Applicants, therefore, respectfully request reconsideration of this objection.

On page 2 of the Office Action, the new claims of the above referenced application were also objected to as follows:

"the added claims are not directed to any invention disclosed in the original patent as evidenced by the claims in the original patent. The newly added claims are directed to processes of making a composition while the original claims were drawn to a composition."

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Applicants respectfully submit, in response, that the law does not require that the claims added at reissue be directed to an invention disclosed in the original claims. Rather, as stated in 35 U.S.C. 251, new claims in a reissue application need only [to] relate to an "invention disclosed in the original patent. (emphasis added)" As stated in Section 1412.01 of the M.P.E.P., "[t]his does not mean that the invention claimed in the reissue must have been claimed in the original patent."

As stated in *In re Amos*, 21 U.S.P.Q.2d. 1271, 1275 when examining new claims in a reissue application:

"the inquiry that must be undertaken to determine whether the new claims are 'for the invention' originally disclosed, to paraphrase *In re Rowand*, is to examine the entirety of the original disclosure and decide whether, through the 'objective' eyes of the hypothetical person having ordinary skill in the art, an inventor could fairly have claimed the newly submitted subject matter in the original application, given the requisite error has been averred. (emphasis added)"

This inquiry is satisfied when:

- (A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

MPEP § 1412.01. Since there is nothing in the specification of U.S. Patent No. 5,652,263 that would indicate an intent not to claim subject matter presented in new claims 16-71, this inquiry requires only that the claims are supported and enabled according to § 112, ¶ 1.

As set forth in paragraph 3 of the Declarations of Wang and Clum, the new claims of the present application claim methods of manufacturing emulsion skin care compositions having one or more of sixteen method features (i.e., (m1) to (m16)). This method and the corresponding sixteen method features are fully disclosed in U.S. Patent No. 5,652,263, as originally filed. Table I below contains a listing of various examples where support can be found in the description of preferred embodiments of the invention. This list is not designed to be a comprehensive listing of all support in the specification, and is not meant to limit the scope of any term or to define any term in the claims.

TABLE I

Method Feature	U.S. PATENT NO. 5,652,263
(m1)	column 10, lines 17-21
(m2)	column 10, lines 21-24
(m3)	column 10, line 25
(m4)	column 10, lines 25-27
(m5)	column 12, lines 26-35
(m6)	column 10, line 5
(m7)	column 5, lines 3-4
(m8)	column 10, lines 30-32
(m9)	column 10, lines 27-30
(m10)	column 6, lines 26-27
(m11)	column 6, lines 1-9
(m12)	column 6, lines 10-17
(m13)	column 6, lines 54-55
(m14)	column 14, lines 32-36
(m15)	column 7, lines 53-56; column 8, lines 6-7; column 10, lines 12-15
(m16)	column 10, lines 27-30

As the method and the various features of the method are clearly set forth in the patent, Applicants assert that they could have claimed each of new claims 16-63 of the present application in the original application. Accordingly, reconsideration of this objection is respectfully submitted.

Accordingly, applicants submit that all pending claims are in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'W. McGowan', is written over a horizontal line.

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